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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,815	04/28/2006	Jonas Scherble	285453US0PCT	6973
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
LENIHAN, JEFFREY S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/577,815

Applicant(s)

SCHERBLE ET AL.

Examiner

Jeffrey Lenihan

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-856)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is responsive to the amendment filed on 6/01/2010.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

4. Claims 1-5, 7, 8, 13, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geyer et al, US5928459, in view of Tada et al, US5225449.

The rejection stands as per the reasons outlined in the previous Office Actions, incorporated herein by reference.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Geyer et al, US5928459, and Tada et al, US5225449, as applied to claim 5 above, and further in view of Stein et al, WO 03/020804.

The rejection stands as per the reasons outlined in the previous Office Actions, incorporated herein by reference.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Geyer et al, US5928459, and Tada et al, US5225449, as applied to claim 5 above, and further in view of Wu et al, US6396451.

The rejection stands as per the reasons outlined in the previous Office Actions, incorporated herein by reference.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Geyer et al, US5928459, and Tada et al, US5225449, as applied to claim 5 above, and further in view of Zacharopoulos et al, US2004/0034932.

The rejection stands as per the reasons outlined in the previous Office Actions, incorporated herein by reference.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Geyer et al, US5928459, and Tada et al, US5225449, as applied to claim 5 above, and further in view of Nieuwendijk et al, US4847908.

The rejection stands as per the reasons outlined in the previous Office Action, incorporated herein by reference.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Geyer et al, US5928459, and Tada et al, US5225449, as applied to claim 5 above, and further in view of Baumann et al, US2002/0037955.

The rejection stands as per the reasons outlined in the previous Office Action, incorporated herein by reference.

Response to Arguments

10. Applicant's arguments filed 6/1/2010 have been fully considered but they are not persuasive.

11. Regarding the combination of references and the amount of t-butyl methacrylate (TBMA): As discussed in the previous Office Actions, Geyer and Tada are directed towards the same field of endeavor-the preparation of polymethacrylimide foams from copolymers of methacrylic acid and methacrylonitrile. As conceded by applicant in the remarks filed on 6/1/2010, Geyer further teaches that up to 20% by weight of methacrylic esters of C1-C4 alcohols may be copolymerized with the methacrylic acid and methacrylonitrile in preparing the polymethacrylimide foam (see remarks, page 8, lines 9-10).

12. Tada discloses the copolymerization of TBMA with methacrylic acid and methacrylonitrile in order to form a polymer foam. One of ordinary skill in the art will recognize that TBMA is a methacrylic ester of t-butyl alcohol, which is a 4-carbon alcohol. As noted in the previous Office Action, Table 1 of Tada shows that it was known in the art that changing the concentration of TBMA in the copolymer foam results in changes in 1) the density of said foam and 2) the moisture absorption properties of the foam. It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Geyer by using TBMA as the methacrylic ester of a C1-C4 alcohol, in order to produce a foam having low moisture absorption properties, as taught by Tada.

13. The examiner disagrees with applicant's statement that Tada requires the use of large amounts of TBMA. As noted by applicant (remarks page 8, lines 3-4), Tada discloses that the amount of TBMA may be as low as 5% by weight. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments; see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments; *In re Susi* 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The disclosure by Tada of examples wherein the TBMA content is greater than the claimed range does not constitute a teaching away from the broader range recited in the reference. Furthermore, as noted in the previous Office Action, Tada explicitly teaches an inventive example wherein the TBMA content is 10 pbw. Tada therefore does not require the use of large amounts of TBMA.

14. Regarding the use of t-butyl acrylate (TBA): The examiner notes that none of the currently pending claims recite the use of TBA as component (B). Arguments regarding TBA therefore are not relevant to the patentability of the currently pending claims.

15. Regarding the allegedly unexpected results: Applicant's arguments regarding the allegedly unexpected results have already been addressed in the previous Office Actions, incorporated herein by reference, with regards to the claimed range for TBMA.

16. Regarding Example 7: The examiner notes that the previous Office Action states that the instant specification compares an inventive example containing 10 pbw TBMA (i.e., Example 6) to a comparative example containing 20 pbw TBMA (i.e., Example 7);

the rationale outlined in the previous Office Action was based on treating Example 7 of the specification as a comparative Example. Per the rationale of record, a comparison of an inventive example containing 10 pbw TBMA to a comparative example containing 20 pbw TBMA does not demonstrate the criticality of the claimed range having an upper limit of 15 pbw.

17. Regarding Comparative Example 8: As stated in the instant specification (see page 15, line 22 to page 16, line 23), Comparative Example 8 does not contain TBMA. A comparison of the properties of inventive examples 2 and 6 to those of comparative examples 7 and 8 does not establish the criticality of the claimed upper limit of 15 pbw. The allegedly unexpected results therefore are not commensurate in scope with the claimed invention and do not demonstrate the criticality of the claimed range for TBMA/TBA content, as discussed in the previous Office Actions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

/Jeffrey Lenihan/
Examiner, Art Unit 1796

/JL/